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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,652	07/25/2003	Scott Basyl Johnston	A4Z01	1402

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EXAMINER

MCCARRY JR, ROBERT J

ART UNIT PAPER NUMBER

3617

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/626,652	Applicant(s) JOHNSTON, SCOTT BASYL	
	Examiner Robert J. McCarry, Jr.	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The claims filed on 01/16/2006, in response to the Notice of Non-Compliance filed on 12/30/2005, have been treated in this Office Action. Applicant is made aware that any amendments made in the now Non-compliant amendment of 10/11/2005 have not been entered into the record. Pending claims 17-32, which are labeled as "New" should be labeled with the claim identifier of "Previously Presented" since no amendments have been made and they were included in the original listing of claims filed on 05/10/2005.

Claim Objections

Claim 26 is objected to. Claim 26 recites "the interconnecting side strip". This lacks antecedent basis in the claims. It appears that claim 26 should depend from claim 24, not claim 25. This will be assumed. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Hutton et al. (US 5,560,093). Hutton shows a sign for displaying indicia. The sign has a housing having a body portion (25, 26) made up of panels (27). The outer surface of the panels is a display portion on which indicia (50) may be attached. The sign comprises at least one collar arrangement (22). It is located at the top end of the sign. It is shown in detail

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in figs 1 and 6. the collar has an opening through which the support element (10) is received. The collar arrangement has individual collar portions of different sizes and arranged in a stepped relationship to one another (figs 1 and 6). The individual collar portion form openings of different sizes. The size of a respective opening can be measured either along the longitudinal axis of the post (10) or orthogonal thereto – either way, one can differentiate different collar portions that form different sized openings.

Still regarding claim 17, the recitation “so that the individual collar portions can be selectively cut or trimmed ... by a fastener” is an intended use or functional recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the Hutton collar portions could theoretically be cut or trimmed to provide an opening of a different size. For example the collar shown in figure 6 could theoretically be cut at the location where the lead line for the reference character “28” intersects the collar portion. This would result in an opening of a different size that could receive a post that had a small protuberance. Since the Hutton structure is capable of performing the intended use or function, it reads on the claim.

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Claim 18, a collar arrangement is located at both the top and bottom end of the sing.

Claim 19, the collar portions are arranged substantially parallel and concentric.

Claim 20, the collar portions comprise alternating flanges and risers.

Claim 21, the flanges are between risers, and the risers are between flanges.

Claim 22, the display portion is either planar or curved.

Claim 23, the display portion is a display panel (27). Sheet (50) can be stapled directly on the panel.

Claim 24, the sign has a side strip (15) that engages portions of housings.

Claim 25, Hutton discloses a backing member (76) can be placed between the housing and support. Fastener (37) holds the housing to the backing member.

Claims 26-29, see figures 3 and 4.

Claim 30, Hutton discloses fastener (37) that is a band of strapping material

Claim 31, Hutton shows that the support element is a post.

Claim 32, the recitation that the sign is a road traffic sign is an intended use. The Hutton sign could be used as a road traffic sign.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. McCarry, Jr. whose telephone number is (571) 272-6683. The examiner can normally be reached on Monday through Friday 7:00am to 3:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Robert J. McCarry, Jr.
Examiner
Art Unit 3617

RJM
February 16, 2006


S. JOSEPH MORANO
SENIOR PATENT EXAMINER
TECHNOLOGY CENTER 3600